

REMARKS

The amendments shown above and these Remarks are made in reply to the Final Office Action mailed September 11, 2009, and this Response is filed within 2 months of the Action. Claims 50-55, 57-84 and 86-98 were examined and remain pending. Reconsideration is respectfully requested.

I. SUMMARY OF THE EXAMINER'S ACTIONS

In the Final Office Action mailed September 11, 2009, the Examiner:

- rejected claims 50-51, 57, 61, 71-79 and 81-84 as unpatentable under §103(a) over U.S. Patent No. 5,562,979 (“*Easterlow*”) in view of U.S. Patent No. 5,942,324 (“*Chu*”);
- rejected claims 52-55 and 80 as unpatentable under §103(a) over the combination of *Easterlow* and *Chu* as applied to claim 50, and further in view of U.S. Patent No. 6,579,397 (“*Spain*”);
- rejected claims 50-51, 57, 61, 71-79 and 81-84 as unpatentable under §103(a) over the combination of *Easterlow* and *Chu* in view of European Patent No. 0556449 (“*Kashiwagi*”);
- rejected claims 58-59 as unpatentable under §103(a) over the combination of *Easterlow* and *Chu* as applied to claim 50, and further in view of U.S. Patent No. 6,106,759 (“*Jarrard*”);
- rejected claim 60 as unpatentable under §103(a) over the combination of *Easterlow* and *Chu* as applied to claim 50, and further in view of U.S. Patent No. 6,000,922 (“*Wagner*”);
- rejected claims 62-66 and 68-69 as unpatentable under §103(a) over the combination of *Easterlow* and *Chu* as applied to claim 50, and further in view of WIPO Publication No. WO2002/090002 (“*Phillips*”);
- rejected claim 67 as unpatentable under §103(a) over the combination of *Easterlow*; *Chu* and *Phillips* as applied to claim 64, and further in view of the English Abstract of Japanese Patent No. 01-259916 (“*Kiichi*”); and
- rejected claim 70 as unpatentable under §103(a) over the combination of *Easterlow* and *Chu* as applied to claim 50, and further in view of U.S. Publication No. 2003/0189475 (“*Blume*”).

II. SPECIFIC RESPONSE TO THE EXAMINER'S ACTIONS

A. Section 103 Rejections Are Traversed

Independent claim 50 stands rejected as obvious over the combination of *Easterlow* and *Chu*, or alternatively, as obvious over the combination of *Easterlow*, *Chu* and *Kashiwagi*. Applicant respectfully traverses the rejection.

In particular, the Examiner asserts that it would be obvious to use ferromagnetic metal particles in *Easterlow*, and then to orient these ferromagnetic particles using the magnetic field of *Chu* so as to provide a uniform appearance in the moulding. Applicant respectfully disagrees.

Applicant submits that the Examiner has improperly combined the *Easterlow* and *Chu* references, and further, that upon starting from the disclosure of either of these documents, there is no clear motivation to combine their teachings. To the contrary, it should be clear that *Easterlow* and *Chu* are directed towards alternative techniques, as is described below, and not the same techniques, so there is truly no motivation to combine these references.

Easterlow relates to an injection process for forming a moulding, and aims to avoid spray painting. (See *Easterlow* at col. 1:55-58, and col. 2:3-20). More specifically, *Easterlow* explicitly states that metallic finishes are often desirable, but recognizes that metallic spray coatings are not suitable because the metallic additive is not oriented in the desired manner, and therefore results in an unsatisfactory coating. (*Id.* at col. 2:21-32). *Easterlow* overcomes the problem of orientation of the metallic particles in a spray coating by instead using an injection moulding process, wherein the metallic particles are caused to align due to the flow of material within the mould. (*Id.* at col. 2:32-36; *see also* col. 5:18-27). Therefore, *Easterlow* teaches the use of an injection moulding process for metallic finishes **as an alternative** to a spray coating process, in order to improve the overall appearance of the metallic effect.

Chu, on the other hand, relates to a method of spray coating a pre-moulded housing, wherein the spray coating may include metallic particles. Since *Chu* discloses a spray coating process, a metallic finish applied using this process is inherently susceptible to the problem described above, namely, that the metallic particles are not oriented in a desired manner after spraying. *Chu* seeks to remedy

this problem by applying a magnetic field to re-orient the metallic particles that have already been sprayed onto the workpiece such that the metallic particles are oriented parallel to the housing surface. (See *Chu* at col.2:59-63 and col. 8:7-14).

Therefore, *Chu* solves the problem that sprayed on metallic particles are poorly oriented by using a magnetic field to manipulate the particles. This is an entirely different and alternative solution to that proposed in *Easterlow*, wherein injection moulding is used to orient the magnetic particles by the flow of the material within the mould. As such, the two techniques are alternatives and there is no real motivation to apply the teachings in *Chu* to use a magnetic field to align metallic particles in the method of *Easterlow*, particularly since the particles described in *Easterlow* have already been aligned by the flow of material, and there is no need to do any further orientation of the particles

Therefore, applicant submits that it would not be obvious to combine *Chu* with *Easterlow* since the metallic particles are already oriented parallel to the exterior surface of the housing in *Easterlow*, and so it is unnecessary to further manipulate the metallic particles using the magnetic field disclosed in *Chu*.

The Examiner asserts that this is not the case, and that the orientation of the metallic particles in *Easterlow* actually depends on the flow lines of the coating material, which depends on the shape of the moulded product. However, *Easterlow* explicitly teaches that the injection process causes the metallic particles to be oriented parallel with the plane of the coating layer 23. (See *Easterlow* at col.5:8-14). Further, *Chu* teaches that the magnetic field orients the metallic particles in a direction that is parallel to the housing surface, i.e., also parallel to the coating layer. (See *Chu* at col. 2:59-63 and col. 8:7-14). Therefore, the teachings of *Chu* would not cause the metallic particles in *Easterlow* to be re-oriented, and thus there is no reason, need or motivation to combine *Chu* with the teaching of *Easterlow*.

The Examiner has further asserted that the combination of *Chu* and *Easterlow* renders claim 50 obvious since the moulded substrate housing disclosed in *Chu* may also contain metallic particles. However, this portion of *Chu* is not considered relevant since the metallic particles in the housing substrate are not manipulated by a magnetic field in *Chu*. The moulded housing is formed and set prior to being spray coated and subjected to a magnetic field. Therefore, the metallic particles in the set housing substrate are not able to be re-oriented by the magnetic

field. Indeed, *Chu* does not even seek to re-orient the metallic particles in the moulded housing substrate because these particles are not subject to the problem of poor orientation that is caused by the spraying of metallic particles. *Chu* only relates to the use of a magnetic field for manipulating metallic particles that are poorly oriented due to being sprayed, and is therefore not relevant to the injection process of *Easterlow*.

Moreover, *Easterlow* does not even disclose or suggest that the metallic particles are ferromagnetic particles which can be manipulated by a magnetic field. The only objective and requirement of the metallic particles described in *Easterlow* is to provide a metallic appearance. There is simply no teaching or suggestion in *Easterlow* that making the particles from a ferromagnetic metal so that they can be manipulated by a magnetic field would provide any benefit, particularly since the metallic particles are already well oriented by the flow of the material in the injection process.

Therefore, for all the foregoing reasons, applicant submits that claim 50 is patentable over the combination of *Easterlow* and *Chu*.

With regard to the cited combination of *Easterlow*, *Chu* and *Kashiwagi*, all the foregoing arguments apply as well.

Further, as with *Chu*, *Kashiwagi* discloses a spray painting technique and so applicant considers this reference no more relevant than *Chu*. Furthermore, as noted above, *Easterlow* simply fails to teach or suggest that the metallic particles should be ferromagnetic particles which are able to be re-oriented by a magnetic field. The metallic particles described in *Easterlow* are merely for providing a metallic appearance. Also, *Easterlow* specifically aims to avoid spray coating techniques such as those of *Kashiwagi*. (See *Easterlow* at col. 1:55-58 and col. 2:3-20).

In short, there is simply no teaching or suggestion in any of the cited prior art documents as to how to manipulate a metallic particle using a magnetic field in a dual injection process, as recited in claim 50. Therefore, claim 50 is considered patentable over the prior art.

Claims 51-55, 57-84 and 86-98 are dependent through claim 50 and are therefore considered patentable for the same reasons.

Claim 61 is dependent from claim 50, and requires that “*said magnetic fields are applied in said mould before said at least one material has cured completely.*”

Applicant submits that there is absolutely no teaching or suggestion in the cited prior art of specifically how to apply a magnetic field during an injection moulding process, as required by claim 61. Therefore, claim 61 is considered patentable.

III. CONCLUSION

Based on the remarks above, reconsideration and allowance of the pending claims is respectfully requested. The Examiner's prompt attention to this matter is greatly appreciated. Should further questions remain, the Examiner is invited to contact the undersigned attorney by telephone.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 501826 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: November 11, 2009

By: /Richard A. Nebb/
Richard A. Nebb
Reg. No. 33,540

VIERRA MAGEN MARCUS & DENIRO LLP
575 Market Street, Suite 2500
San Francisco, California 94105-4206
Telephone: (415) 369-9660
Facsimile: (415) 369-9665